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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,916

09/26/2003

T. Debucne Chang

CHANG-001

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06/27/2006

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EXAMINER

APANIUS, MICHAEL

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,916

Applicant(s)

CHANG ET AL.

Examiner

Michael Apanius

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-15 and 17-19 is/are allowed.
- 6) ☒ Claim(s) 1-10, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed 4/3/2006. The Examiner acknowledges the amendments to claims 1, 8, 11 and 19-21; the cancellation of claim 16; the replacement drawing sheets; and the amendments to the specification. Currently, claims 1-15 and 17-21 are pending.

Drawings

2. The replacement drawings are accepted.

Claim Objections

3. Claim 8 is objected to because of the following informality: it appears that "a body using said retrieval wire" should be --a patient's body using said retrieval wire when the sensing device is disposed in the body part-- to further clarify the language. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 9, 10, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Silver (US 6,442,413). In regards to claims 1, 20 and 21, Silver discloses a diagnostic system, comprising: a sensing device (20) having a retrieval wire (antenna; see column 11, lines 7-8) configured to extend from an interior of a body part, said sensing device configured to collect data; a deployable housing (stent 14), said housing having a body defining an interior and an exterior, said housing is configured to allow fluid to flow through said housing, wherein said sensing device is disposed in said interior of said housing (column 10, lines 50-53); a disposer (figure 7B) for disposing said housing having said sensing device into said body part, wherein said wherein said deployable housing expands when disposed into said body part to prevent ejection of said sensing device from said body part; and a processing device (figure 1B) configured to remotely receive said data from said sensing device. In regards to claim 2, the sensing device can be a thermal sensing device (column 13, lines 31-33). In regards to claim 3, the processing device has an RF transceiver that is a passive transceiver. As the processing device has an antenna (34) and a transmitter (44) within a single remote circuit (32), the processing device is deemed to have a RF transceiver because the elements for receiving and transmitting are within the same remote circuit. In regards to claim 4, the retrieval wire is configured to operate as an antenna (column 11, lines 7-8). In regards to claim 5, the housing can be made from a non-dissolvable biocompatible material. In regards to claim 6, the disposer is a catheter mechanism comprising a sheath (108) and a push bar (110). In regards to claim 7, the data is transmitted by

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radio frequency (column 11, line 5). In regards to claim 9, a urine sensing device (24) is disposed proximate said retrieval wire. Note that the sensing device is capable of detecting urine that is contacted with the sensing device by sensing an analyte of interest within urine. Due to the fact that the urine sensing device is connected to the sensing device, the urine sensing device is capable of sensing urine. In regards to claim 10, the processing device is configured to transmit data (column 12, line 4-7).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 5, 6, 8, 9, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yachia et al. (US 6,746,421) in view of Yachia et al. (US 6,293,923) and Matsuura et al. (US 6,682,473).

8. In regards to claims 1, 20 and 21, Yachia ('421) discloses a system, comprising: a deployable housing (figure 2b), said housing having a body defining an interior and an exterior, said housing is configured to allow fluid to flow through said housing (through ports 6); and a disposer (31 and 33) for disposing said housing having said sensing device into said body part, wherein said wherein said deployable housing expands when disposed into said body part to prevent ejection of said sensing device from said

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body part. In regards to claim 5, the housing can be made from a non-dissolvable biocompatible material. In regards to claim 6, the disposer is a catheter mechanism comprising a sheath (31) and a push bar (33).

9. Although Yachia ('421) discloses that the invention may be used to measure intravesicular parameters such as pressure (column 4, lines 48-51), Yachia ('421) does not elaborate and does not expressly disclose a sensing device having a retrieval wire or a processing device.

10. Yachia ('923) teaches and elaborates on a pressure sensing device (14c in figure 8) disposed in an interior of a housing that can be considered a urine sensing device and further teaches a processing device (17) for the purpose of monitoring bladder pressure.

11. Matsuura teaches an anti-microbial retrieval wire (figure 24) configured for retrieval from an exterior of the body part for the purpose of aiding in the removal of a device and providing a user with the capability of instant removal in the event that the user feels compelled to extract the device (column 22, lines 34-48).

12. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have used a pressure sensing device and processing device as taught by Yachia ('923) in the system of Yachia ('421) in order to monitor bladder pressure as briefly stated by Yachia ('421).

13. Furthermore, it would have been obvious to one having ordinary skill in the art at the time of invention to have used a retrieval wire as taught by Matsuura in the system of Yachia and Yachia in order to aid in the removal of a device and provide a user with

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the capability of instant removal in the event that the user feels compelled to extract the device.

Allowable Subject Matter

14. Claims 11-15 and 17-19 are allowed.

Response to Arguments

15. In response to the Applicant's argument that the Silver reference does not teach "a sensing device having a retrieval wire configured to extend from an interior of a body part", the Examiner respectfully submits that Silver does teach this limitation. Applicant goes on to argue that Silver discloses an antenna for transmitting signals that does not extend from an interior to an exterior of a body part. However, the language used in the claims does not require that the retrieval wire extend to an exterior of a body part. The wire of Silver does extend from an interior of a body part when the device is appropriately implanted.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,704,353 discloses a urinary diagnostic catheter. US 6,398,718 discloses an intravesicular device.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Apanius whose telephone number is (571) 272-5537. The examiner can normally be reached on Mon-Fri 8:30am-5pm.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA



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